

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Applicant:	§	
Oleg B. Rashkovskiy	§	Art Unit: 2623
	§	
Serial No.: 09/690,549	§	Examiner: Rueben M. Brown
	§	
Filed: October 17, 2000	§	Atty Docket: BKA.0006US
	§	
For: Storing Advertisements	§	Conf. No.: 2613

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**PETITION TO THE OFFICE OF THE DEPUTY COMMISSION  
FOR PATENT EXAMINATION POLICY UNDER § 1002.02(b)(3)**

This petition seeks to have a review of the Group Director's decision to reopen prosecution in this case after reversal on appeal.

**Issues Presented**

The first issue presented is whether prosecution can be reopened on an issue not involving knowledge of uncited art. The second issue presented is can prosecution be reopened where it is obvious the Examiner did not know of the uncited references. The third issue presented is whether prosecution can be reopened based on references that do not differ significantly from what was already analyzed on appeal.

**Background Facts**

After being reversed on appeal, prosecution was reopened based on the statement "The Examiner has specific knowledge of the existence of a particular reference or references that indicate non-patentability of the appealed claims." See page 3. The Examiner then cites five new references. Plainly, under any objective review, the Examiner, dissatisfied with the decision

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on appeal, went and did a new search, contrary to the strictures of the Manual of Patent Examining Procedure.

Moreover, for the first time after appeal, the Examiner raises a new Section 112 rejection. The Examiner asks where are the following words in the specification. See office action at paragraph 9. Certainly, one can ask why does the Examiner suddenly question the support for these terms after using the terms freely himself in arguing them throughout the prosecution in this case?

### **Analysis**

#### **1. Reopening an Appeal Based on a New Search is Not Permitted**

The Manual of Patent Examining Procedure allows for the reopening of prosecution upon finding a new reference (M.P.E.P. § 1214.04). But the Manual is explicit that a new search should not be done. *Id.* Here, any reasonable review of the record shows a new search was done.

#### **2. Reopening Prosecution is Not Permitted to Pose a Section 112 Rejection**

Moreover, there is no basis in the Manual of Patent Examining Procedure (or anywhere else) to raise new rejections after reversal not based on prior art that could have been raised before. Thus, the raising of the Section 112 rejection is completely inappropriate because there is no basis for raising new rejections, other than the finding of a new reference as precipitating the new rejection. Since there is no basis for the Section 112 rejection, it should be stricken.

Plainly, the Section 112 rejection is so deficient on its face that it is inappropriate to raise it, particularly at this stage in the proceedings. The law is clear that the exact same words do not need to be used in the specification and the claims. See M.P.E.P. § 2163.02 (no need to use the same words in the specification and claims). That is the sole and total basis for the belated and improper Section 112 rejection.

#### **3. Reopening Prosecution is Improper When the New References Do Not Make Out a *Prima Facie* Rejection**

The newly cited references are deficient in the same way as the previously cited references. Most clearly, the newly cited reference to Jernagen is totally devoid of any

instructions for updating. Instead, there are no instructions in Jernagen at all. All Jernagen does is simply plug the advertisements in. After he updates the advertisements, he just plugs them in periodically.

But the application and the claims require that there be instructions for updating. There are no instructions that are received by the receiver for updating. They just receive the advertisement. The importance of this is explained in the Decision on Appeal at page 3. There, it is explained that the instruction indicates when to perform the updating operation. Moreover, the Board notes that the specification distinguished updated advertisements from an entirely new replacement advertisement. That is all that Jernagen teaches. He teaches replacing the existing advertisements with replacement advertisements and he provides no instructions whatsoever for doing so. Therefore, the rejection is deficient for reasons already explained by the Board.

### **Conclusion**

Therefore, reconsideration of the decision to reopen prosecution is requested and, further, even if prosecution were to be reopened, the Section 112 rejection should be stricken.

Respectfully submitted,

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